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In the Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-951

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,

Petitioners,

v.

KOCKUM INDUSTRIES, INC.,

Respondent.

REPLY TO BRIEF IN ANSWER TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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Respondent's brief avoids coming to grips with the four reasons for granting the writ of certiorari set forth in the petition. The principal argument in the brief is one going to the merits of the case, i.e., that the claims of the two patents in suit, Andersson and Leffler, do not "patentably distinguish from the prior art merely by functional statements" (Resp. Br., p. 2).

Respondent's concentration on such an argument supports the petition, and underscores the importance of correcting the erroneous decision of the Ninth Circuit.

The basis for the Ninth Circuit's reversal of the District Court's holding that both patents were in-

valid on the ground of anticipation, was its determination that both patented devices use a so-called "screwing action"*, and the devices shown in the prior art patents disclose only a "camming action".

In trying to identify what structural differences between the patented and prior art devices would lead to these supposedly different performances, the court of appeals correctly recognized that the only possible difference must be in the construction of the alleged "sharp edge" of the patented devices—the edge intended for engaging the end of an oncoming log. This edge is what the court referred to as "the heart of the self-opening mechanism in issue . . . on which appellant [respondent] relies as imparting novelty." (Pet. App., p. A-3). And, with respect to this edge, the court went on to say:

> "However, at this critical point of novelty the claims of the patents revert to descriptions in terms of function." (Pet. App., pp. A-3-4).

The court then went on to hold that this fatal defect, under *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364 (1938), had been cured by the third paragraph of 35 U.S.C. § 112. This means that the second paragraph of § 112, which has been substantially the same for more than one hundred years,

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* That determination was obviously wrong because none of the Leffler claims mentions anything about "screwing action". Even if we assume that some of the claims mention "screwing action", and that such functional language could support patentability, the Leffler claims are still invalid in view of the earlier disclosure of the same invention in claim 12 of the Andersson patent which specifically refers to "screwing action".

should be disregarded in view of the third paragraph that was added in 1952.

Even if the court could disregard the second paragraph of § 112 in favor of the third paragraph, the claims here in issue must still fall. The specifications of the patents are just as vague and indefinite as are the claims. They provide us with no objective standard for determining when the log-engaging edge of a tool is "sharp" so as to be distinguishable from prior art tool edges. There is simply no structural definition of the term "sharp" anywhere in the patents. A reading of those portions of the patents quoted in footnotes 2 and 3 of the Ninth Circuit's opinion confirms the indefiniteness of the word "sharp" as used by the patentees (Pet. App., pp. A-4-6).

The public has no way of determining what the limits of the alleged inventions are, so that someone who wishes to avoid these patents will know how to build debarker tools without "sharp" log-engaging edges.

Respondent's admission (Resp. Br., p. 6) that the Ninth Circuit incorrectly applied the *Wabash* case supports the petition. The fact that in 1961, in *Locklin* v. *Switzer Brothers, Inc.*, 299 F.2d 160 (9 Cir., 1961), that court may have correctly understood *Wabash*, does not remedy the erroneousness of, or the confusion caused by, the present decision of the Ninth Circuit.

Respondent's brief does not, because it cannot, refute the argument that there is a direct conflict be-

tween the decision below of the Ninth Circuit and those of this Court in *Wabash* and *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942). With respect to the Second, Seventh and Eighth Circuit decisions referred to in the petition, it is clear that in those circuits a combination-type claim, which uses functional language at the alleged point of novelty, would be invalidated. Respondent's attempts to distinguish these cases on their facts is beside the point.

On pages 2-4 of respondent's brief, references are made to a number of cases in various circuits, and particularly to the discussion of functional claims by the Court of Customs and Patent Appeals in *Application of Swinehart*, 439 F.2d 210 (C.C.P.A., 1971). That decision is far less pertinent than *Application of Hammack*, 427 F.2d 1378 (C.C.P.A., 1970). In *Hammack* the court specifically dealt with the requirements of the second paragraph of § 112, which requirements are precisely those that are here in issue. The court had the following to say (427 F.2d at 1382):

> "All provisions of the statute must be complied with in order to obtain a patent. The requirement stated in the second paragraph of section 112 existed long before the present statute came into force. Its purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. Compare United Carbon Co. v. Bin-

ney & Smith Co., 317 U.S. 228, 63 S. Ct. 165, 87 L. Ed. 232 (1942), Kaiser Industries Corp. v. McLouth Steel Corp., 400 F.2d 36 (6th Cir. 1968)."

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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